

37



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/742,623	12/19/2003	Jay C. Hsu	KCX-797 (18372)	3984
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DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			COTTON, ABIGAIL MANDA	
			ART UNIT	PAPER NUMBER
			1617	
DATE MAILED: 04/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/742,623

Applicant(s)

HSU, JAY C.

Examiner

Abigail M. Cotton

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to the amendment submitted January 26, 2006. Claims 1-3 and 5-18 are pending in the application, with claims 19-48 having been canceled and claim 1 having been newly amended. Accordingly, claims 1-3 and 5-18 are being examined on the merits herein.

The objection to the specification is withdrawn in view of Applicant's amendment to recite the proper patent numbers and authors for the reference as cited on page 4 of the specification.

The rejection of claims 1-3, 5 and 16-18 under 35 U.S.C. 103(a) over U.S. Patent No. 6,503,412 to Wen Schroeder in view of WO 02/41869 to Hsu et al, is being withdrawn in view of Applicant's amendment to claim 1 to recite that the product has water in an amount greater than 75% by weight of the composition. Schroeder teaches that composition having "up to 40% by weight" of a solvent, but does not teach the composition having greater than 75% by weight of a solvent such as water.

Applicant's arguments filed January 26, 2006, regarding the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,552,020 to Smith et al. in view of WO 02/41869 to Hsu et al. have been fully considered but they are not persuasive.

The claims as newly amended are rejected as follows.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,552,020 to Smith et al, in view of WO 02/41869 to Hsu et al, published May 30, 2002.

Smith et al. teaches tissue products having improved bulk and softness by adding one or more softeners/debonders and a silicone glycol copolymer (see abstract, in particular.) Smith et al. teaches that the silicone glycol can comprise a chemical structure that corresponds to silicone glycol compounds recited in claim 2 (see column 1, line 65 through column 2, line 20, in particular.) Smith et al. furthermore teaches that softeners/debonders can comprise silicone quaternaries (see column 1, lines 32-40, in particular), and that the silicone quaternaries can comprise a chemical structure that

Art Unit: 1617

corresponds to the silicon quaternary ammonium compounds recited in claim 3 (see column 6, lines 19-34, in particular.)

Smith et al. exemplifies providing an aqueous softener blend of 4 weight percent of a softener/debonder (quaternary ammonium compound) and 1 weight percent of a silicone glycol (see Example 1, in particular.) Thus, Smith et al. teaches providing a softener/debonder in a weight percentage range that meets the limitation of being from about 0.01% to about 20% by weight, and teaches providing the silicone glycol in a weight percentage that meets the limitation of being from about 0.01% to about 20% by weight, as recited in claim 1. Smith et al. does not exemplify silicone glycol and a softener/debonder that specifically comprises a silicon quaternary ammonium compound in the recited weight percentages. However, as Smith et al. teaches that silicon quaternary ammonium compounds and quaternary ammonium compounds are among the compounds that can be provided as softener/debonders, it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the exemplified quaternary ammonium compound with the silicon quaternary ammonium compound in the amount taught by Smith et al, with the expectation of providing a suitable softener/debonder for the composition. Note that it is considered that "[I]t is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them

Art Unit: 1617

flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980.)

Furthermore, as Smith et al. teaches that the solution is aqueous, and teaches a combined net weight of softener/debonder and silicon glycol of only 5%, it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide water in an amount greater than about 40%, and also greater than about 75%, as recited in claim 1, because Smith et al. teaches providing 95% by weight of an aqueous solution.

Regarding claims 17-18, Smith et al. exemplifies providing the composition on a sheet having a basis weight of 33.9 grams per square meter (see Example 1, in particular), and thus teaches providing a paper product having the basis weights recited in claims 17-18.

Smith et al. teaches efforts are continually being made to improve upon the various properties of tissue in order to provide better products for the consumer, and that softness is one of these properties (see column 1, lines 5-15, in particular.)

However, Smith et al. does not specifically teach providing an emollient in an amount between about 0.01% to about 20% by weight, as recited in claim 1. Smith et al. also does not specifically teach providing the fatty alcohol in the percent weight

Art Unit: 1617

recited in claims 8-9. Smith furthermore does not specifically teach providing the emulsifier and skin conditioning agent having the percentage weights as recited in claims 10-14. Smith et al. also does not specifically teach that an add-on level of the entire composition in the range recited in claim 15, and also does not specifically teach providing an antimicrobial agent or preservative, as in claim 16.

Hsu et al. teaches a paper product with a lotion composition comprising an emollient in an amount up to 20% by weight of the lotion (see abstract, in particular.) Hsu et al. teaches that the emollient provides a number of benefits, including helping to maintain a smooth, pliable appearance of the skin and enhancing the ability of the skin of users of the paper product to retain water (see paragraph bridging pages 5-6, in particular.) Regarding claim 5, Hsu et al. teaches that the emollient can be present in an amount of between about 1% to about 10% by weight of the lotion, which meets the limitation of being between about 0.01% to about 10% (see page 5, first full paragraph, in particular.) Regarding claims 6-7, Hsu et al. teaches that a suitable emollient can comprise a linear alkyl ester of benzoate, such as a C<sub>12</sub>-C<sub>15</sub> alkyl benzoate (see paragraph bridging pages 5-6, in particular.)

Regarding claims 8-9, Hsu et al. teaches that a fatty alcohol can be provided in the lotion composition in an amount of between about 10% by weight to about 30% by weight, which is considered to meet the limitation of being between "about" 0.01% to "about" 20% by weight as recited in claim 8. Hsu et al. furthermore teaches that

Art Unit: 1617

suitable fatty alcohols can comprise cetyl alcohol, stearyl alcohol, and others, as recited in claim 9. Hsu et al. teaches that the fatty alcohols provide various benefits to the paper-based products, including retaining a greater amount of the lotion of the surface of the paper product to contact and transfer to the users skin, as well as allowing a lower add-on level which reduces the cost of the product (see page 6, first full paragraph, in particular.)

Hsu et al. furthermore teaches that the paper product can comprise an emulsifier to aid in dispersing water and oil phases of the lotion, which can be present in an amount of between about 5% to about 20% by weight of the lotion (see page 7, first full paragraph), which meets the limitation of being between about 0.01% to about 20% as recited in claim 10. Hsu et al. teaches that suitable emulsifiers include steareth-2, steareth-20 and steareth-21 (see paragraph bridging pages 7 through 8, in particular), which are polyoxyethylene stearyl ethers, as recited in claim 11.

Hsu et al. also teaches that the lotion can comprise a skin conditioning agent in an amount of between about 10% to about 40% by weight (see page 9, first full paragraph, in particular), which is considered to meet the limitation of being from “about” 0.01% to “about” 20% by weight as recited in claim 12. Hsu et al. teaches that a suitable skin conditioning agent can comprise a humectant (see page 9, second full paragraph, in particular), as recited in claim 13. Hsu et al. teaches that a humectant can be provided to provide a number of benefits, including enhancing retention of



moisture on the skin of a user of the paper product (see page 9, second full paragraph, in particular.) Hsu et al. furthermore teaches that a suitable humectant can comprise glycerin (see paragraph bridging pages 9 through 10, in particular.)

Regarding claim 16, Hsu et al. teaches that the composition can comprise an antimicrobial agent or preservative (see page 11, first full paragraph and page 12, first full paragraph, in particular.) Hsu et al. teaches that the antimicrobial agent or preservative can be provided to disinfect a user's skin or to inhibit the growth of microbes thereon (see page 11, first full paragraph and page 12, first full paragraph, in particular.)

Regarding claim 15, Hsu et al. teaches that a suitable add-on level of the lotion composition is between about 1% by weight to about 15% by weight of the paper product (see abstract, in particular), which meets the limitation of being between "about" 0.5% to "about" 10% by weight of the paper-based product as recited in the claim. Hsu et al. also teaches that the add-on level of the lotion can generally vary depending on the desired effect of the lotion on the product attributes and the specific composition.

Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the emollient, fatty alcohol, emulsifier, humectant and antimicrobial agent or preservative of Hsu in the tissue product of Smith et al, because Smith et al. teaches providing a composition on a paper based product to

Art Unit: 1617

improve the product, and furthermore teaches the desirability of improving upon the various properties of tissue to provide better products for the consumer, whereas Hsu et al. teaches a lotion having components that impart improved properties to the paper product. Thus, one of ordinary skill in the art would have been motivated to provide the emollient, fatty alcohol, humectant, etc, ingredients of Hsu et al. in the tissue paper product of Smith et al, with the expectation of providing a tissue product having improved properties, such as the ability to impart benefits including moisture retention to the skin.

One of ordinary skill in the art at the time the invention was made would furthermore have found it obvious to provide the composition as taught by Smith et al. and Hsu et al. in an add-on level as taught by Hsu et al, because Hsu et al. teaches that this is a suitable add-on level for providing a composition onto a paper-based product that imparts benefits to the skin, and Hsu et al. and Smith et al. are both concerned with providing compositions on the paper-based product for use as facial/bath tissues and on skin. Accordingly, one of ordinary skill would have been motivated to provide the composition of Smith et al. and Hsu et al. in the add-on level taught by Hsu et al. with the expectation of providing a paper-based product having the composition in an amount suitable for use of the product as facial/bath tissue and on skin.

### ***Response to Arguments***

Applicant's arguments filed January 26, 2006 regarding the rejection of the claims over Smith et al. and Hsu et al. have been fully considered but they are not persuasive.

In particular, Applicants argue that one of ordinary skill in the art would not find it obvious to combine the teachings of Smith et al. with those of Hsu et al, because Smith teaches providing a composition having softeners at the wet end of a tissue machine, prior to formation of a tissue web, whereas Hsu et al. teaches treating paper products with a composition, and thus applying after the tissue has been formed. Applicants assert that because Smith et al. and Hsu et al teach providing the composition at different stages in the tissue-making process, that it would not be obvious to combine the compositions, i.e. the composition of Smith et al. and the emollient of Hsu et al, into a single formulation. The Examiner respectfully disagrees. While Smith et al. does not specifically teach providing the emollient as recited, Smith et al. does teach that it is desirable to improve the softness of the tissue, as discussed above. Hsu et al. teaches that the emollients impart tissue softness. Accordingly, it would be obvious to one of ordinary skill in the art to combine the emollient into the composition of Smith et al, with the expectation of improving the softness of the tissue having the composition. The other components taught by Hsu et al. as imparting benefits to tissue products are similarly obvious to combine into the Smith et al. reference.

Art Unit: 1617

Regarding samples 19-22 of the Examples, the Examiner notes that while the examples show good results for compositions having the claimed limitations, the examples do not show evidence of unexpected results, as it is expected that modifying the composition of the products will alter the softness, stiffness, silkiness, strength of the products, etc. Furthermore, it is noted that evidence of unexpected results is required to be reasonably commensurate in scope with the claimed invention. See, e.g., *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 777 (Fed. Cir. 1983). The claims recite a composition having any silicone glycol with any silicone quaternary ammonium compound, whereas the examples only show results for a few specific combinations. It should be noted that a showing of unexpected results must be based on evidence, not argument or speculation. *In re Mayne*, 104 F.3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed. Cir. 1997)

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1617

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**